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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,884	08/21/2001	Eiji Hayakawa	1217.012USU/KPG 1134	6378

7590 09/09/2004

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EXAMINER
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CHU, JOHN S Y

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/933,884

Applicant(s)

HAYAKAWA ET AL.

Examiner

John S. Chu

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 47-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-64, 76-87 and 96-98 is/are rejected.
- 7) ☒ Claim(s) 65-75 and 88-95 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office action is in response to the amendments filed May 12, 2004.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 47-64, 76-87 and 96-98 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by HALEY et al.

The claimed invention is drawn to the following:

**47. (New) An imageable composition comprising:**

**an acid curable composition;**

**an acid generator; and**

**a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid.**

**76. (New) An imageable element comprising:**

**a substrate; and**

**an imageable coating on a surface of the substrate, the coating comprising: an acid curable composition; an acid generator; and a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid.**

and

- 96. (New) A method of making an imageable element including a substrate and an imageable coating on the substrate, the method comprising the steps of:**
- contacting a substrate with an imageable composition dissolved or dispersed in a suitable solvent, wherein the imageable composition comprises an acid curable composition, an acid generator, and a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid; and**
  - drying to remove solvent, leaving an imageable coating on the substrate.**

HALEY et al anticipates the claimed invention at Example 1, column 7, line 64 – column 8, line 40. The example discloses a resole resin, a novolak resin, a onium salt and a infrared dye with a sulfonate counter ion. The claims are anticipated by the example in HALEY et al.

The arguments by applicant have been carefully considered with respect to the definition of a colorant, however the rejection is repeated wherein the infrared absorbing dye is seen as a colorant. The current specification generically defines the colorant on page 8, lines 6 and 7 as being a colorant dye or a colorant pigment. The infrared dyes of HALEY et al are asserted to have color in visible light even though the  $\lambda_{max}$  may be in the infrared spectrum. Thus the rejection is repeated unless shown by applicant that the infrared dyes are non-colorant and transparent in visible light. HALEY et al clearly asserts that additional colorants may be added to the composition, however that does not exclude the infrared dyes as being colorants. The Office does not have the ability to test the infrared dyes and because the infrared compounds are asserted to be dyes, a color is expected with the compound.

3. Claims 47-64, 76-87 and 96-98 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by KUNITA.

The claimed invention has been recited above and is included by reference.

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KUNITA et al anticipates the claimed invention at Examples 1-4 to 1-8 and 2-4 to 2-8 as seen in Table 10 of column 55. Likewise Comparative examples 1,2, 3-8 found in Table 11 anticipates the claimed invention at Table 11.

This rejection is repeated for the reasons as stated above wherein the infrared dyes are seen to meet the claimed term for colorant.

4. Claims 65-75, and 88- 95 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the references of record disclose the claimed dependent limitations as recited in the aforementioned claims to the diazo resin and the additional additive photothermal additive.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. GRIES et al is cited of interest which discloses a dye of Victoria Blue FBR ( a dye with a non-volatile counter ion) in the a diazonium resin containing composition which crosslinks upon exposure to UV light.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

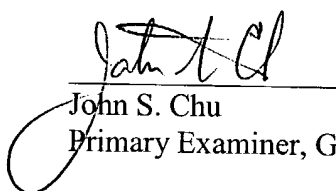
Art Unit: 1752

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for the USPTO is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
John S. Chu  
Primary Examiner, Group 1700

J.Chu  
September 7, 2004